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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,553	12/18/2001	Audrey A. Sherman	56009 US002	2489

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT PAPER NUMBER

1712

10

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ASIX

Office Action Summary

Application No. 10/028,553		Applicant(s) SHERMAN ET AL.	
Examiner Christopher M. Keehan		Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

The objection to the disclosure has been withdrawn due to applicant's arguments.

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Claim Rejections - 35 USC § 103

The rejection of claims 1-8, 10-18, 32, 33, 36, 40, and 41 under 35 U.S.C. 103(a) as being unpatentable over Joseph et al. (6,107,222) has been maintained and is as set forth in the previous office action.

The rejection of claims 1-3, 7-23, 27-41 under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) has been maintained and is as set forth in the previous office action.

The rejection of claims 24-26 under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) in view of Joseph et al. (6,107,222) has been maintained and is as set forth in the previous office action.

R sponse to Arguments

Applicant's arguments filed 4/29/03 have been fully considered but they are not persuasive. Regarding applicant's arguments concerning Joseph et al. (6,107,222), applicant has amended claim 1 to include "solvent-based" in claim 1. However, as applicant pointed out, Joseph et al. disclose water-based systems, and water is considered a solvent. Therefore, Johnson et al. appear to still read on the claims and are as set forth in the previous office action.

Regarding applicant's arguments concerning Sherman et al., the claims are drawn to a silicone tackifying resin (page 18, line 25-page 20, line 13), a polydiorganosiloxane polyurea copolymer (page 10, line 9-col.13, line 7), and a plasticizer or processing aid (page 9, lines 21-23). Sherman et al. disclose the components of applicant's composition. Applicant has argued that one of ordinary skill in the art would not have been motivated to achieve the PSA as described in the present application, and to include a processing aid in the effective amount as applicants have discovered and taught in the application. However, applicant is reminded that the specification cannot be relied on to impart limitations to the claims that are not recited in the claim. Although a claim should be interpreted in light of the specification disclosure, it generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975). The claims do not contain the limitations as argued by applicant.

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The rejection as set forth in the previous office action stated that although Joseph et al. do not appear to specifically disclose wherein the silicone tackifying resin and polydiorganosiloxane polyurea copolymer are generally uniformly distributed, Joseph et al. do disclose adding a plasticizer by blending into the composition, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a generally uniform distribution as instantly claimed because the materials and process of Joseph et al. are the same as instantly claimed, and at least similar materials would have been expected to yield at least similar results. The rejection as set forth in the previous office action stated that although Sherman et al. do not appear to specifically disclose wherein the silicone tackifying resin and polydiorganosiloxane polyurea copolymer are generally uniformly distributed, Sherman et al. do disclose that the plasticizer can be added at any point in the processing, such as when blending the polydiorganosiloxane copolymer and the silicone resin (page 8, lines 15-19), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a generally uniform distribution as instantly claimed because the materials and process of Sherman et al. are the same as instantly claimed, and at least similar materials would have been expected to yield at least similar results. It should be noted that applicant has not argued the merits of these grounds of rejections. Applicant has only argued that Joseph et al. does not read on solvent-based, and that Sherman et al. does not teach or disclose what is disclosed in applicant's specification.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan
July 7, 2003

cmw

Robert A. Dawson

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700